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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,259	07/18/2003	Steven Michael Hausman	2002P20760US01	3269

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Siemens Corporation
Intellectual Property Department
170 Wood Avenue South
Iselin, NJ 08830

EXAMINER	
HASSAN, AURANGZEB	
ART UNIT	**PAPER NUMBER**
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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TECHNOLOGY CENTER 2100

Siemens Corporation
Intellectual Property Department
170 Wood Avenue South
Iselin NJ 08830

In re Application of: Hausman, et al.
Application No. 10/622,259
Filed: July 18, 2003
For: AUTOMATIC CONFIGURATION OF A REMOTE MODEM

DECISION ON PETITION UNDER 37 C.F.R. § 1.181

This is a decision on the petition, filed 19 December 2007, and a second petition filed February 20, 2008, under 37 CFR § 1.181 to reconsider and reverse the examiner's Final rejection mailed 19 October 2007, as being premature.

The petition is **DISMISSED**.

On 19 December 2007, applicant's counsel filed a petition to the Director under 37 CFR § 1.181 to seek relief from actions of the examiner Aurangzeb Hassan in relation to the Final Office action mailed 19 October 2007. In the petition, applicant's counsel alleged that the rejection of claims 1-32 was not clear, and specifically, pointed out that it was not clear which of the two cited references disclosed some specific limitations of claim 1. Applicant also alleges that examiner failed to respond to all Applicants' arguments; thus, rendering the Final Office action premature.

MPEP § 1201 states, in part:

> The United States Patent and Trademark Office (Office) in administering the Patent Laws makes many decisions of a *>substantive< nature which the applicant may feel deny him or her the patent protection to which he or she is entitled. The differences of opinion on such matters can be justly resolved only by prescribing and following judicial procedures. **Where the differences of opinion concern the denial of patent claims because of prior art or **>other patentability issues<, the questions thereby raised are said to relate to the merits,** and appeal procedure within the Office and to the courts has long been provided by statute >(35 U.S.C. 134)<.
>
> The line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the **>Director of the U.S. Patent and Trademark Office (Director)< should be carefully observed. The Board will not ordinarily hear a question **>that< should be decided by the *>Director on petition<, and the *>Director< will not ordinarily entertain a petition where the question presented is **>a matter appealable to the Board<. However, since 37 CFR 1.181(f) states that any petition not filed within 2 months from the action complained of may be dismissed as untimely and

since 37 CFR 1.144 states that petitions from restriction requirements must be filed no later than appeal, petitionable matters will rarely be present in a case by the time it is before the Board for a decision. In re Watkinson, 900 F.2d 230, 14 USPQ2d 1407 (Fed. Cir. 1990).

MPEP 707.07(f) [R-3] states in part:

> Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.
> .....
> The importance of answering applicant's arguments is illustrated by In re Herrmann, 261 F.2d 598, 120 USPQ 182 (CCPA 1958) where the applicant urged that the subject matter claimed produced new and useful results. The court noted that since applicant's statement of advantages was not questioned by the examiner or the Board of Appeals, it was constrained to accept the statement at face value and therefore found certain claims to be allowable. See also In re Soni, 54 F.3d 746, 751, 34 USPQ2d 1684, 1688 (Fed. Cir. 1995) (Office failed to rebut applicant's argument).

37 C.F.R. § 1.181(f) states, in part:

> The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition ...

A review of the prosecution history in the instant application and the petition indicates that there is a disagreement between the examiner and applicant's counsel in the interpretation of the claim language and prior art, and whether all of applicants' arguments were addressed by the examiner. All claims have been rejected under 35 U.S.C. §§ 103(a). Thus, it is apparent that such a disagreement regarding claim interpretation and rejection is appealable, not a petitionable matter.

Pursuant to MPEP § 1201, the petition is **DISMISSED.**

A petition under 37 C.F.R. 1.181 requires no fee. The application file is being forwarded to the Tech Support staff to refund the fee of $130.00, that was charged to petitioner on December 20, 2007.

From there, the application will be forwarded to the examiner to act on the After Final Amendment filed by Applicant on December 19, 2007.

Any inquiry concerning this decision should be directed to Mano Padmanabhan whose telephone number is (571) 272-4210.

Jack Harvey, Director
Technology Center 2100
Computer Architecture, Software, and Information Security